

Appl. No. : **09/808,421**
Filed : **March 13, 2001**

REMARKS

Applicant thanks the Examiner for her careful and thoughtful examination of the present application. By way of summary, Claims 1-6 and 74-75 were pending in this application, and remain pending for consideration.

Rejection Of Claims 1-6 and 74-75 Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected Claims 1-6 and 74-75 under 35 U.S.C. § 112, ¶ 2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter for which Applicant regards as the invention. The specific rejections made by the Examiner, and Applicant's response to these rejections, are discussed below.

Claims 1, 2 and 74

With respect to Claims 1, 2, and 74, Examiner has stated that it is unclear what "a first service-enhancing system," "a second service-enhancing system" and a "communication-enhancing system" are composed of. Examiner further states that it is unclear from Claim 2 how "enhancing the availability to said at least some potential clients of said listing information" enhances availability. Although the claims are correct, the claims have been clarified, without altering their scope, to refer to computer-based systems. These claim clarifications are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such clarifications. Withdrawal of the rejection of Claims 1, 2 and 74 under 35 U.S.C. § 112, second paragraph is requested.

Claims 3 and 75

With respect to Claims 3 and 75, Examiner has stated that the terms "said certain standards being more specific, or higher than those generally accepted or legally required to practice in the industry of said service provider" in Claims 3 and 75 are relative terms which render the claims indefinite. Although the claims are correct, the claims have been clarified, without altering its scope, to remove said allegedly relative terms. These claim clarifications are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such clarifications. Withdrawal of the rejection of Claims 3 and 75 under 35 U.S.C. § 112, second paragraph is requested.

Appl. No. : **09/808,421**
Filed : **March 13, 2001**

Claims 4-6

Examiner does not discuss the rejection of Claims 4-6 under 35 U.S.C. § 112, ¶ 2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter for which Applicant regards as the invention. Applicant nonetheless respectfully submits in light of the above arguments with respect to Claims 1-3, 74 and 75, that Claims 4-6 are believed to be patentable.

Rejections Under 35 U.S.C. § 101

The Examiner rejected Claims 1-6, 74 and 75 under 35 U.S.C. § 101 alleging that the claims are drawn to non-statutory subject matter.

Claims 1-6

Applicant notes that:

“[o]ffice personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971).” (emphasis added, MPEP § 2106).

As such, Applicant submits that if the claims encompass any practical application, then the claims satisfy 35 U.S.C. § 101, and are not properly rejected as being drawn to non-statutory subject matter. In light of this, Applicant respectfully directs the Examiner to amended Claim 1 and original Claim 4, which depends from Claim 3. The recited subject matter embodies practical applications within the scope of the respective independent claims.

Examiner states that the claims must somehow apply, involve, use or advance the technological arts. As amended, the claims discuss use of a computer-based system. Applicant notes that Claim 1 provides an embodiment in which a first computer-based service-enhancing system provides services. Claim 4 provides a computer software-based process. As such, Claims 1-6 involve the technological arts. Additionally, as discussed above, Claims 1 and 4 include embodiments with practical applications within the scope of their respective independent claims. For example, Applicant notes that information identifying a service provider is made

Appl. No. : **09/808,421**
Filed : **March 13, 2001**

available to potential clients. Applicant thus respectfully submits that a rejection under 35 U.S.C. § 101, non-statutory subject matter, is plainly improper.

Applicant requests that such rejection of independent Claim 1, Claim 2 which depends from Claim 1, independent Claim 3, and Claims 4-6 which depend from Claim 3, be withdrawn.

Claims 74 and 75

Examiner does not discuss the rejection of Claims 74 and 75 under 35 U.S.C. § 101 as drawn to non-statutory subject matter. Applicant nonetheless respectfully submits in light of the above comments with respect to Claims 1-6, that Claims 74 and 75 are believed to satisfy 35 U.S.C. § 101.

Rejection Of Claims 1-2 and 74 Under 35 U.S.C. § 102(e)

In the Office Action, Examiner rejected Claims 1-2 and 74 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,470,338, issued to Rizzo et al. ("Rizzo"). Applicant respectfully traverses this rejection because Rizzo fails to identically teach every element of the claim. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim).

Claim 1

As currently amended, Claim 1 recites (emphasis added):

1. **(Currently Amended)** A method of facilitating services, said method comprising:
generating listing information identifying a service provider;
making said listing information available to potential clients of said service provider; and
receiving an agreement from said service provider to use a first computer-based service-enhancing system to provide services to each client obtained as a result of said making said listing information available.

Applicant submits that Rizzo does not disclose "receiving an agreement from said service provider to use a first computer-based service-enhancing system to provide services to each client" as recited by Claim 1. Rizzo discloses "[m]ember law firms, and member individual attorneys, are preferably signed up with the system... When law firms and attorneys are signed as members they preferably provide similar information about themselves as was entered by the potential clients, e.g., jurisdictions in which they practice, areas of expertise, size of law firm,

Appl. No. : 09/808,421
Filed : March 13, 2001

and e-mail address” (Col. 3, line 67-Col. 4, line 7). Thus, Rizzo discloses a system in which service providers enter data on their characteristics. Rizzo does not disclose a system in which service providers agree to use a service-enhancing system to provide services to a client as recited by Claim 1. Consequently, Rizzo cannot anticipate Claim 1.

Because the reference cited by the Examiner does not disclose, teach or suggest receiving an agreement from a service provider to use an electronic service-enhancing system to provide services to a client, Applicant asserts that Claim 1 is not anticipated by Rizzo. Applicant therefore respectfully submits that Claim 1 is patentably distinguished over the cited art and Applicant respectfully requests allowance of Claim 1.

Claim 2

Claim 2, which depends from Claim 1, is believed to be patentable for the same reasons articulated above with respect to Claim 1, and because of the additional features recited therein.

Claim 74

As currently amended, Claim 74 recites (emphasis added):

74. **(Currently Amended)** A system for facilitating services, said system comprising:

means for representing with computer-readable data characteristics of and identification of a service provider;

means for allowing potential clients to search said characteristics over a computer network and receive a representation of data identifying said service provider; and

means for **receiving agreement from said service provider to use a computer-based communication-enhancing system to provide services to each client** obtained via said means for allowing potential clients to search said characteristics.

Claim 74, is believed to be patentable for the same reasons articulated above with respect to Claim 1, and because of the additional features recited therein. Applicant therefore respectfully submits that Claim 74 is patentably distinguished over the cited references and Applicant respectfully requests allowance of Claim 74.

Appl. No. : **09/808,421**
Filed : **March 13, 2001**

Rejection Of Claims 3-6 Under 35 U.S.C. § 103(a)

The Office Action rejected Claims 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Rizzo in view of U.S. Patent No. 6,144,943, issued to Minder ("Minder"). Applicant respectfully traverses this rejection for the following reasons.

Claim 3

Applicant notes that Examiner states that Minder discloses an agreement between a contractor to adhere to certain quality standards. Examiner contends that Applicant's claimed invention results if Rizzo's invention is implemented with Minder's quality standards agreement. Applicant respectfully disagrees with Examiner's characterization of and conclusions regarding Minder.

Applicant submits that Minder does not disclose "receiving an agreement from said service provider to adhere to certain standards of care in providing services to each client" as recited by Claim 3. Minder discloses a method wherein a client can select a specific minimum grade to be delivered by a service provider (Col. 4, lines 8-10). Thus Minder only discloses a client driven system wherein the client selects a grade that it would like a service provider to deliver. Minder nowhere discloses, teaches or suggests a method comprising receiving an agreement from a service provider to adhere to certain standards of care in providing services to a client. Neither Minder nor Rizzo teach or suggest such aspect of Applicant's invention. Furthermore, no evidence exists as to any motivation for one of ordinary skill to combine the housekeeping notions disclosed in Minder with anything disclosed by Rizzo.

Thus, for the reasons set forth above, Applicant respectfully submits that Minder adds nothing to Rizzo that could render obvious Applicant's claimed invention. For this reason, Applicant requests allowance of Claim 3.

Claims 4-6

Because Claims 4-6 depend from Claim 3, they include all the limitations of Claim 3 as well as other limitations of particular utility. Therefore, for at least the reasons discussed above in regard to Claim 3, Claims 4-6 are patentably distinguished over Rizzo in view of Minder. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 4-6 and pass the claims to allowance.

Appl. No. : 09/808,421
Filed : March 13, 2001

Rejection Of Claim 75 Under 35 U.S.C. § 103(a)

The Office Action rejected Claim 74 under 35 U.S.C. § 103(a) as being unpatentable over Rizzo in view of U.S. Patent No. 6,334,133, issued to Thompson et al. ("Thompson"). Applicant respectfully traverses this rejection for the following reasons.

For reasons similar to those described above with respect to Claim 74, Applicant submits that Claim 75 includes limitations not taught or suggested by Rizzo. Applicant submits that Thompson does not disclose, teach or suggest those missing limitations, nor is there any evidence of anything that motivated one of ordinary skill to combine any teachings in Thompson with any teachings in Rizzo. Therefore, Applicant submits that Claim 75 is patentably distinguished over Rizzo in view of Thompson.

Claim 75 depends from Claim 74, and thus includes all the limitations of Claim 74 as well as other limitations of particular utility. Therefore, Claim 75 is patentably distinguished over the cited prior art. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 75 and pass the claim to allowance.

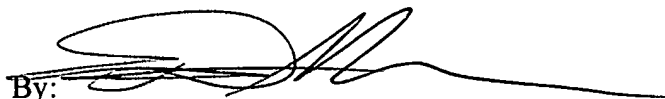
Conclusion

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved. Also, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 4/21/06

By: 

Douglas G. Muehlhauser
Registration No. 42,018
Attorney of Record
Customer No. 20,995
(949) 760-0404